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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/293,509 04/15/99 OSAWA

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QM32/0828

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EXAMINER

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ROHM & MONSANTO PLC
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WHITE, C

ART UNIT	PAPER NUMBER
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3713

DATE MAILED:

08/28/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/293,509

Applicant(s)

OSAWA, AKIRA

Examiner

Carmen D. White

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 4 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the plurality of principal game playing states" in lines 10-11. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites "adapted to" in line 3. This language makes the scope of the claim unclear.

RCE

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on April 18, 2001 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 14-16 of copending Application No. 09/268,960. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the instant claimed invention are drawn to a gaming machine that has a primary game and a secondary game that achieves the same objective as the claimed invention of copending Application No. 09/268,960. The claim language of the instant application is not exactly the same as that of Application No. 09/268,960. However, the invention of the instant application achieves all the same functions as the instant invention of Application No. 09/268,960.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell, II or Farrell.

Regarding claim 1, Applicant is referred to the detailed explanation of the final office action (1/3/01) for a description of the non-amended claim features. Applicant amended the claim to include the feature of the display of the image on said secondary display corresponding to a history of each predetermined display state of the principal game and an indication of a one of the plurality of principal game playing states that has a likelihood of winning a subsequent principal game. The examiner asserts that, while not explicitly stated in the Marnell II and Farrell references, the gaming machines of the references are functionally capable of achieving the instant claim feature of "the display of the image on said secondary display corresponding to a history of each predetermined display state of the principal game and an indication of one of the plurality of principal game playing states that has a likelihood of winning a subsequent principal game". Farrell or Marnell II teaches that the symbols that appear on the win line in the principal game are placed in the secondary matrix (Farrell- Fig. 1; Marnell II-Fig. 1). Therefore, it is obvious to a person of ordinary skill in the art that the secondary display of Farrell or Marnell II provides a "history" of the predetermined display state of the principal game. Further, the player, by looking at the symbols that are placed in the secondary display is capable of seeing various patterns of symbols from the reels of the primary game in order to "anticipate" the likelihood of obtaining various combinations of symbols in the subsequent principal game. This is a matter of choice well within the functional

capabilities of the Farrell or Marnell II reference. While, this feature is not explicitly stated in Farrell or Marnell II, the gaming machine of Farrell or Marnell II could serve this purpose, if so desired. Therefore, the examiner asserts that it would have been obvious to modify the invention of Farrell or Marnell II to include the determination of the likelihood of winning a subsequent game by viewing the secondary display in order to increase the player's excitement and gaming activity on the game machine. Applicant has not recited any physical structure in the apparatus claim of instant claimed invention that differs from that of Farrell or Marnell II. Applicant merely recites a purpose for the secondary display that is not explicitly recited in Farrell or Marnell II. However, it is an obvious matter of choice to use the secondary display of Farrell or Marnell II for the same purpose as Applicant, if so desired.

Regarding claims 2-4, Marnell, II or Farrell further discloses the secondary display indicating symbol images that correspond to a respectively associated one of the principal game playing states (Marnell II-abstract; Farrell- Fig. 1, #6, #2; #57).

Regarding claims 5-7, Marnell, II or Farrell further discloses providing an award to a player when the secondary display screen satisfies a predetermined condition (Marnell II- col. 7, lines 7-14; Farrell- Fig. 1, #9 and page 9, lines 25-34).

Regarding claim 8, Marnell, II or Farrell further discloses the resetting of the secondary display (Marnell II- col. 7, lines 25-34 and col. 6, lines 23-27; Farrell- page 12, lines 20-25).

Regarding claim 14, Marnell II further discloses the primary game being a slot game and a poker game (Fig. 1 and Fig. 2).

Regarding claims 9-12, Marnell II or Farrell discloses all the elements of the claims as discussed above. While Marnell II teaches the clearing of all of the display areas Marnell II is silent on disclosing the clearing of a single display area. Farrell discloses resetting the display screen or holding some of the display areas for another game (p. 12, lines 20-30). However, it would be an obvious design choice to clear either one or all areas according to whether or not the player wanted to maintain some symbol positions in order to increase the player's chances of winning in subsequent games. Therefore, it would have been obvious to include this feature in Marnell II or Farrell.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell, II (5,393,057) or Farrell (GB 2242300A) in view of Wilson, Jr. et al (6,004,207) or Adams (5,848,932).

Regarding claim 13, Marnell II or Farrell discloses all the limitations of the claim as discussed above. Marnell II or Farrell lacks disclosing a multiplied payout. In an analogous gaming machine, Wilson Jr. et al or Adams discloses the multiplication of a payout value (Wilson Jr. et al- abstract; Adams- abstract). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Marnell II or Farrell because it is well known in the art to provide multiplied payouts in slot machines to increase players' interests in the game.

Response to Remarks

Applicant argues neither the Marnell II nor the Farrell reference teaches or suggests “any interrelationship between the principal and secondary games, wherein the principal game can be won **by reference to** the secondary game”. Further, Applicant states that there is no teaching in the applied references that the result of the matrix game can be applied to **anticipate** a win in the principal game. The examiner directs Applicant’s attention to the above claim rejection for an explanation of this claim feature. Also, Applicant, on page 8 of the arguments recites a passage from page 26, lines 6-15 of the specification that reads as follows:

As described above, the secondary game played on the secondary display screen is separate from the variable display that displays the principal game, but is related to the result of the principal game, thereby enhancing the player’s interest in continuing to play the entire game. The secondary game by the secondary display screen proceeds while indicating histories of the (winning) states displayed in the past by the variable display. Therefore, the player can know whether the completion of the secondary game is near or not. Also, it is easy for the player to know at glance what kind of (winning) pattern has to be displayed in the principal game for completion of the secondary game so that the player may play the game with high interest and expectation. The player can endeavor to win the principal game by paying attention to the progress of the secondary game, thereby greatly elevating the player’s interest in the game.

This passage was recited by Applicant to show support in the specification for Applicant’s assertion that the playing of the secondary game will provide indication of the likelihood of winning the principal game. Applicant states above that “it is easy for the player to know at glance what kind of (winning) pattern has to be displayed in the principal game for completion of the secondary game...” This passage seems to indicate, to the examiner, that playing of the **primary game** will provide indication of the likelihood of winning the **secondary game**. However, the next sentence, above, states, “The player can endeavor to win the principal game by paying attention to the progress of the secondary game...” This statement appears to be inconsistent with the previous statement. Nonetheless, the examiner has considered this area of the disclosure. The mere statement that the player can **endeavor to win** the principal game by **paying attention to** the progress of the secondary game does not support the argument by Applicant that “the principal game can be won by reference to the secondary game”. This argument seems to indicate that the secondary game affects the winning probability of the principal game. Applicant’s instant disclosure and claims do not support this argument.

Applicant argues that the references of Marnell II and Farrell do not teach the feature of new claim 15. However, the application does not include a claim 15. Further, Applicant argues that the references do not teach “a gaming machine wherein a player can earn a profit or receive an award that is increased

in response to a secondary game that is played supplemental to a principal game". However, Applicant has not claimed this feature.

The examiner has taken notice that Applicant intends to provide a Terminal Disclaimer upon allowance of the claims. Thus, the double patenting rejection of claims 1-14 remains until such time.

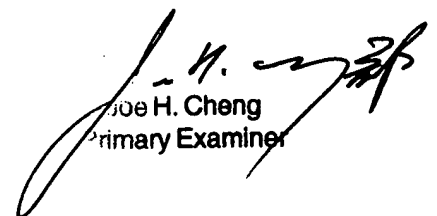
USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.


C. White
Patent Examiner


Joe H. Cheng
Primary Examiner

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.